

REMARKS

In accordance with the forgoing, claims 46-81 stand pending and rejected with claims 1-45 and 70-83 canceled without prejudice or disclaimer as to the subject matter thereof; in addition, a portion of the specification is objected to.

Herewith, Applicants amend independent claims 46 and 58, add no new claims and cancel claims 1-45 and 70-83.

Entry and favorable consideration of the amendments and remarks presented herewith is earnestly solicited. Applicants aver that the instant Response is intended to place the application in condition for allowance without introducing any issues or new matter requiring additional consideration or searching by the Examiner.

I. Objection to the Specification

The Examiner alleges that the specification fails to provide proper antecedent basis for the claimed subject matter.

Applicants respectfully traverse said objection.

First of all, the specification is replete with express disclosure and depictions of the claimed subject matter. For example, the notion that a wholly-implantable medical device and implanting an electroporation device wholly within a body is amply supported throughout the specification. For instance, FIG. 2 is described as follows at page 9 of the application as filed (and of course forms part of the specification):

Figure 2 is an implantable medical device (IMD) for electroporation cancer treatment in accordance with one embodiment of the invention, wherein the IMD is shown implanted within a body of a patient;

FIG. 1 also fully supports the allegedly unsupported and claimed subject matter, to wit (at page 10, lines 13-25):

Figure 1 illustrates a method of treating cancer in accordance with one exemplary embodiment of the invention. In general, a programmable, implantable medical device (IMD) in accordance with the present invention is implanted at 100. The IMD is operable to deliver electroporation therapy as further described below. A therapy profile defining drug delivery and electroporation parameters may be programmed into the IMD at 202 either prior to or after implantation. A chemotherapy drug is delivered (either locally or systemically) to the target tumor at 104. Optionally, the temperature of the tissue in and around the target tumor may be elevated at 106 to improve electroporation efficiency as further described below. Electroporation therapy, which includes one or more high voltage electrical pulses across the target tumor, may be initiated at 108 in accordance with the therapy profile programmed at 102.

In addition, at the last paragraph of page 19 of the application the following passage is included in the specification relating to a “fluid conduit” (i.e., delivering a drug to the body via a fluid conduit):

After termination of the HF stimulus at 522, the prescribed quantity of cancer therapy bolus is delivered at 524. The bolus may be delivered from reservoir 314 to catheter 220 using pump 316 (see Figures 2 and 3). The prescribed quantity of drug bolus is controlled by logic and control circuitry 302 based upon a programmed quantity value stored at 526.

Applicant avers that the objections to the specification stand traversed and, if the Examiner does not agree and withdraw the objections, reserves the right to bring forth additional specific disclosure and drawings depicted the allegedly omitted material. Applicant also invokes the concept of inherency as those of skill in the art upon reviewing the application as filed would surely find all claim limitations supported either expressly or under principles of inherency.

II. Claim Objections

The Examiner objects to claims 46-81 because of the use of “said device” in line 5 of claim 46. Applicant points out that the preamble *can* provide antecedent basis for claim elements (as here) but nevertheless amends the phrase thus obviating the objection.

III. Claim Rejections under 35 U.S.C. 112

Claims 53, 68, 69, 77, and 78 stand rejected as allegedly indefinite.

Applicant respectfully disagrees with the grounds of rejection but nevertheless in order to expedite prosecution of the application, amends said claims thereby rendering them sufficiently definite and precise.

IV. Rejections under 35 U.S.C. 102

Claims 46-48, 50-53, 56, and 57 stand rejected as allegedly anticipated by the '485 patent to Whitehurst (Whitehurst).

Applicants respectfully traverse the ground of rejection.

For Whitehurst to anticipate the rejected claims it must disclose *each and every claim limitation* and if not, the rejection cannot stand.

With respect to the rejected claims Applicants respectfully suggest that Weaver fails to disclose or depict a “wholly-implantable medical device” for carrying out the claimed method(s).

As such Whitehurst does not support the rejection since all rejected claims include this limitation.

Applicants respectfully request that the ground of rejection based solely upon Whitehurst be withdrawn so the claimed invention may proceed to issuance as U.S. Letters Patent.

V. Rejections under 35 USC §103

Claim 49 is rejected over Whitehurst in view of the '493 patent to Hofmann (Hoffman).

Claims 54 and 55 stand rejected as allegedly unpatentable over Whitehurst in view of the '837 patent to Sterzer (since claims 72 and 74-80 are herewith canceled no response is required regarding same).

Claims 58, 59, 63-65 and 67-70 stand rejected as allegedly unpatentable over the '069 patent to Weaver in view of Sterzer (since claim 71 is herewith canceled no response is required regarding same).

Claim 60 stands rejected as allegedly unpatentable over Weaver in view of Sterzer and further in view of Hofmann.

Claims 61, 62, and 66 stand rejected as allegedly unpatentable over Weaver in view of Sterzer and further in view of Whitehurst.

However, Whitehurst, Hofmann nor Weaver references include any disclosure regarding a wholly-implantable medical device they cannot support a *prima facie* obviousness rejection and these grounds also fail to form a basis for a proper obviousness rejection.

IV. Conclusion

It is believed that all pending claims are now in condition for allowance. Applicants request that the Examiner issue a Notice of Allowance in due course so the claimed invention may timely pass to issuance as U.S. Letters Patent.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned attorney to attend to these matters. The Commissioner is authorized to charge any deficiencies and credit any overpayments to Deposit Account No. 13-2546.

Respectfully submitted,

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Page 11 of 11

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